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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
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10/056,757

01/23/2002

Suresh Golwalkar

45706.0400

4968

7590

02/27/2004

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EXAMINER

DANG, HUNG XUAN

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/056,757 | Applicant(s) GOLWALKAR ET AL. | |
| | Examiner Hung X Dang | Art Unit 2873 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55-57 and 59 is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-17, 19, 21-24, 26-32, 34, 36-54 and 58 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 18, 20, 25, 33 and 35 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The Information disclosure Statements filed on 7/28/03 has been considered.

It is noted that the German patent has been considered to the best of the ability of the examiner without benefit of translation.

Claims Rejection Under 35 USC - 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-10, 13-17, 19, 21-24, 26-32 and 34-54, are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Tatsuno et al** (6,341,027).

Tatsuno et al discloses module for optical communication which comprises a semiconductor laser (2), an optical transmission medium (1) disposed proximate the semiconductor laser (2), an encapsulant (7) surrounding a portion of the semiconductor laser (2) and a portion of the optical transmission medium (1), a electrode (8) is arranged on the substrate (3) to be electrically connected to the semiconductor (2), a lead portion of the a leadframe (15), a guide groove (4) to receive guide pins, a amplifier (11), a light detector (6) (see figures 1, 3, 4 and the related disclosure).

It should be noted that although claims 36-54 are "method claims", the method steps consist of the broad steps of "creating", "attaching", "encapsulating", "forming",

"polishing", "coating" and "removing" etc and therefore these steps would be inherently satisfied by the apparatus of the reference as modified.

Double Patenting Rejection

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 09/911,918. Although the conflicting claims are not identical, they are

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not patentably distinct from each other because both applications claim the same subject matter such as a microelectronic device, an optical transmission medium, an encapsulant surrounding a portion of the semiconductor laser (2) and a portion of the optical transmission medium and an electrical connector coupled to the microelectronic device.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 58 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 51 of copending Application No. 09/911,918. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the same subject matter such as an electrical connector; an optoelectronic component flip-chip mounted to the electrical connector; a microelectronic device coupled to the electrical connector; a transmission medium disposed proximate the electrical connector, the transmission medium comprising relay lens elements and anti-reflection coating; an encapsulant surrounding at least a portion of the connector and at least a portion of the microelectronic device; and a guide groove formed within the encapsulant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

4. Claims 55-57 and 59 are allowed.

Claims 11, 12, 18, 20, 25, 33 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reasons For Allowance

5. The following is an Examiner's Statement of Reasons for Allowance:

There was no prior art found by the examiner that suggested modification or combination with the cited prior art so as to satisfy the combination of the present independent claim 55 which include an optoelectronic component flip-chip mounted attached to a first portion of the electrical connector, a microelectronic device attached to a second portion of the electrical connector; an optical transmission medium made of fiber bundles disposed proximate the electrical connector.

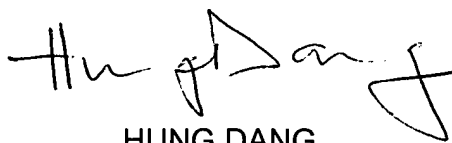
There was no prior art found by the examiner that suggested modification or combination with the cited prior art so as to satisfy the combination of the present independent claim 56 which include an optoelectronic component flip-chip mounted to the electrical connector; a microelectronic device coupled to the electrical connector; a transmission medium disposed proximate the electrical connector, the transmission medium comprising relay lens elements and anti-reflection coating.

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There was no prior art found by the examiner that suggested modification or combination with the cited prior art so as to satisfy the combination of the present independent claim 57 which include an optoelectronic device flip-chip mounted to a first portion of the electrical connector; a microelectronic device electrically coupled to the electrical connector; a transmission medium transparent in the visible and mid infrared regions of the radiation spectrum disposed proximate the electrical connector, the transmission medium comprising relay lens elements and anti-reflection coating.

There was no prior art found by the examiner that suggested modification or combination with the cited prior art so as to satisfy the combination of the present independent claim 59 which include an optoelectronic device flip-chip mounted to the electrical connector; a wavelength demultiplexing transmission medium disposed proximate the electrical connector, the medium comprising relay lens elements and anti-reflection coating; a microelectronic device coupled to the electrical connector.

6. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (571) 272-2326.



HUNG DANG

PRIMARY EXAMINER

TC 2800

2/04